

Ser. No. 10/517,802

### Remarks

Claims 1-59 were pending in the application. Claims 1-5, 14-16, 20-23, 26-31, 34, 35, and 42-59 were rejected. Claims 8-13, 17-19, 24, 25, 32, 33, and 36-41 were merely objected to and no claims were allowed. By the foregoing amendment, no claims are canceled, claims 1, 14, 46, 48-51, 53, and 55 are amended, and no claims are added. No new matter is presented.

### Request to Withdraw Finality

Applicant requests reconsideration of the finality of the Office action as being premature and requests the finality be withdrawn.

If necessary for consideration, Applicant requests that this request be treated as a petition.

The Office action asserted that Applicant's amendment necessitated the new ground(s) of rejection.

MPEP 706.07(a) states that a "final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims." MPEP 8, Rev. 6, p. 700-83, col. 2 (9/2007). That section further provides that the action "should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed." *Id.* at 700-82, col. 2.

In the present application, at least the first prohibition on finality is clearly implicated by the 35 U.S.C. 112(2) rejection of claim 14. The subject language was as-filed. The rejection should have been made in the first action so that Applicant could have the opportunity to respond.

### Interview Request

Applicant requests the courtesy of a telephonic interview to discuss any outstanding issues. In particular, the rejections of claims 14 and 53 merits an interview to work out acceptable language should issues remain.

### Allowable Subject Matter

Applicant appreciates the indication of allowable subject matter in claims 8-13, 17-19,

Ser. No. 10/517,802

24, 25, 32, 33, and 36-41.

Claim Rejections-35 U.S.C. 112

Claims 14, 26, 46, 47, and 53 were rejected under 35 U.S.C. 112(2). Applicant respectfully traverses the rejection.

Regarding claim 14, it was asserted that "the comparison to 'a part of the operator's body' is an unknown value and therefore 'the predetermined value' cannot be determined."

Regarding claim 46, the term "the tool" was noted as lacking antecedent basis. By the foregoing amendment, the second instance of this has been corrected to "the moving part".

Regarding claim 53, the claim has been amended for antecedent basis of the two noted terms.

Claim Rejections-35 U.S.C. 102

Claims 1, 2, 5, 6, 20, 21, 27-29, 44-46, 48-51, and 54-57 were rejected as being anticipated by Lindstrom (US6644080). Applicant respectfully traverses the rejection.

Claim 1 and the other independent claims are amended in one form or another to identify use with a moving part having end-to-end length and that the light is emitted along the length of the part. Support is found at paragraph [0031]. This allows detection of obstructions approaching the moving part from either side, therefore ensuring safety of the operator. Lindstrom identifies use and configuration to position a worksheet, not provide a safety. Abstract. Lindstrom provides illumination via one or more light systems which do not emit parallel light and illuminate from the front of the tool. There is therefore no protection provided for safety purposes, as it is not possible to ascertain distances between the tool and objects approaching the tool along the length of the tool. It is not possible to determine whether an obstruction either in front or behind the tool is moving towards the hazardous region under the tool.

Regarding claims 48 and 55, there has been no application of 35 U.S.C. 112(6) as is required by *In re Donaldson*.

Claims 1-5, 7, 14, 22, 23, 28-31, 34, 35, 42-44, 46, 48-52, and 54-59 were rejected as being anticipated by Fornerod et al. (US4772801). Applicant respectfully traverses the rejection.

Ser. No. 10/517,802

Fornerod et al. disclose the illumination of an area around the piece of material to be bent which then casts a corresponding shadow. However, the device utilises a plurality of holes provided in a cover through which the received light passes. Photodiodes are used to receive the light passing through the holes. By determining which holes are shadowed by the work being bent, the plane of the work and therefore the angle of the bend can be determined.

Fornerod et al. is not described as being a system for safety. Fornerod et al. clearly identifies use to control bending angle. Col. 4, lines 36&37. Only sufficient holes are provided to determine the plane of the work being bent to calculate the bend angle. Other than this received light, no further information can be obtained regarding other obstructions which may create a shadow. The device of the present invention however illuminates the entire region and light passing through this region is received sufficient to identify any obstructions existing in the region. Specifically, the independent claims identify that the illumination of the region is such that the boundaries of the shadowed regions within the illuminated region can be determined. This allows any obstructions such as the hand of the operator to be detected and the position of these obstructions with reference to the moving part to be ascertained. Such an arrangement is not disclosed in Fornerod et al., which can only ascertain whether some points are obstructed at any given time.

Regarding claims 48 and 55, there has been no application of 35 U.S.C. 112(6) as is required by *In re Donaldson*

#### Claim Rejections-35 U.S.C. 103

Claims 15 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fornerod et al. in view of Dissey (US6444973). Applicant respectfully traverses the rejection.

The citation is purely a hindsight reconstruction. There is no sufficient explicit analysis (*e.g.*, under *Graham v. John Deere Co.*). Dissey was asserted, without support, as identifying a safety system. Office action, page 5, line 1. No safety system use was mentioned in Dissey.

Furthermore Dissey's abstract was cited as a motivation to combine "in order to improve the overall accuracy and range of the detection apparatus". Page 6, lines 10&11. However, the full abstract reads:

A detection apparatus and method for detecting the direction to a light

Ser. No. 10/517,802

source. The detection apparatus comprises a strobe lamp for emitting a high intensity beam of light and a region-based detector, e.g., a quadrant light detector, for receiving a portion of the high intensity beam of light. In employing a strobe lamp, the overall accuracy and range of the detection apparatus are improved.


Fornerod et al. does not appear to have the basic quadrant detector and associated direction detection for which the strobe is asserted as an improvement. Thus, this does not appear to represent the case of simply improving one basic apparatus in the same way as prior basic apparatus has recently been modified.

How does the office propose to combine? In the absence of such articulation, we only have a combination of words from a keyword search. This puts Applicant at a disadvantage. For example, if the details of the combination are articulated, Applicant will then be able to identify inconsistencies, incompatibilities, and the like.

What reason would cause one to have sought any change to Fornerod et al., let alone the particular change from Dissey? Where is there reason to believe one of ordinary skill in the art would have found Fornerod et al. deficient for its purposes? Where is the expectation of success in curing these deficiencies?

Accordingly, Applicant submits that claims 1-59 are in condition for allowance. Reconsideration and further examination are requested. Please charge any fees or deficiency or credit any overpayment to our Deposit Account of record.

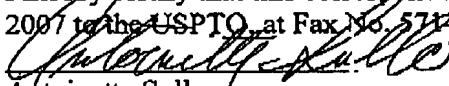
Respectfully submitted,

By   
William B. Slate  
Attorney for Applicants  
Reg. No.: 37,238

Telephone: 203-777-6628  
Telefax: 203-865-0297

Date: December 3, 2007

I hereby certify that this correspondence is being facsimile transmitted this 3<sup>rd</sup> day of December, 2007 to the USPTO, at Fax No. 574-273-8300.

  
Antoinette Sullo